APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,238	02/07/2000	Gregory A. Stobbs		9957

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EXAMINER
WONG, LESLIE

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 03/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/499,238	STOBBS ET AL.
	Examiner	Art Unit
	Leslie Wong	2177

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>07 February 2000</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) __ is/are allowed.

6)☒ Claim(s) <u>1-3 and 5-10</u> is/are rejected.

7)☒ Claim(s) <u>4</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)		4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .	
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) ☐ Notice of Informal Patent Application (PTO-152)	
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6) ☐ Other: .	

DETAILED ACTION

Specification

1.   The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

Drawings

2.   The drawings are objected to because they fail to show necessary textual labels

of features or symbols in Fig. 1 as described in the specification. For example, placing

a label, "client computer", with element 20 of Fig. 1, would give the viewer necessary

detail to fully understand this element at a glance. A descriptive textual label for each

numbered element in these figures would be needed to better understand these figures

without substantial analysis of the detailed specification. Any structural detail that is of

sufficient importance to be described should be labeled in the drawing. Optionally, the

applicant may wish to include a table next to the present figure to fulfill this requirement.

See 37 CFR 1.83. 37 CFR 1.84(n)(o), recited below:

> "(n) Symbols. Graphical drawing symbols may be used for conventional elements
> when appropriate. The elements for which such symbols and labeled
> representations are used must be adequately identified in the specification.
> Known devices should be illustrated by symbols which have a universally
> recognized conventional meaning and are generally accepted in the art. Other
> symbols which are not universally recognized may be used, subject to approval
> by the Office, if they are not likely to be confused with existing conventional
> symbols, and if they are readily identifiable.

> (o) Legends. Suitable descriptive legends may be used, or may be required by the
> Examiner, where necessary for understanding of the drawing, subject to approval by the
> Office. They should contain as few words as possible."

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) do not apply to the examination of this application as the application

being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35

U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Claims 1, 2, 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rivette et al. (U.S. Patent 6,014,663).

Regarding claim 1, **Rivette et al.** ("Rivette") teaches a method-implemented

patent portfolio analysis method (i.e., document development and maintenance tool

(DDMT) 202; col.3, lines 25-40)comprising:

a).   retrieving a corpus of patent information from a database, said information

including the claim text of at least one claim (col.6, line 38 – col.7, line 17);

b).   analyzing the claim text of said at least one claim to generate a claim

breadth metric (col.8, lines 47-53);

c).   associating said claim breadth metric with said claim text and storing said associated metric in a computer-readable dataset (col.8, lines 34-42).

Regarding claim 2, **Rivette et al.** further teaches a step of analyzing the claim text includes counting the number of words in said claim text and generating a claim breadth metric therefrom (col.8, lines 47-53).

Regarding claim 5, **Rivette et al.** further teaches a step of displaying said patent information in a sorted order based on said claim breadth metric (Fig.10, col.9, lines 12-25; col.13, line 45 – col.14, line 10).

Regarding claim 6, **Rivette et al.** further teaches a step of analyzing the claim text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus (col.8, lines 34-42).

Regarding claim 7, **Rivette et al.** further teaches a step of displaying said claim text such that said one clause is visually presented differently than the other of said clauses (col.10, lines 55-63; col.11, lines 29-65).

Regarding claim 8, **Rivette et al.** ("Rivette") further teaches a method-implemented patent portfolio analysis method (i.e., document development and maintenance tool (DDMT) 202; col.3, lines 25-40)comprising:

a).   retrieveing a corpus of patent information from a database (col.6, line 38 – col.7, line 17);

b).   analyzing said patent information to generate a category metric metric (i.e., specification terms or claims terms, etc. col.9, lines 31-49);

c).   associating said claim breadth metric with said claim text and storing said associated metric in a computer-readable dataset (col.8, lines 34-42).

Regarding claim 9, **Rivette** further teaches a step wherein said patent information includes patent classification information and wherein said analyzing step is performed by defining a plurality of categories of mapping classification information said categories such as "reissue", "reexam", etc. (col.7, lines 33-40; col.9, lines 20-49).

Regarding claim 10, **Rivette** further teaches wherein said patent information includes claim text information to be analyzed and wherein said analyzing step includes:

a).   defining an eigenspace representing a training population of training claims each training claim having associated training text (col. 8, lines 34-43)

b).   representing at least a portion of said training claims in said eigenspace and associating a predefined category with each training claim in said eigenspace (col. 9, lines 20-49); and

d).   projecting the claim text information to be analyzed into said eigenspace

(i.e., calculating number hits or re-index, etc. col.11, lines 29-65) and associating said

projected claim text the predefined category of the training claim to which it is closest

within the eigenspace (col.9, lines 26-49).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rivette et

al.** (U.S. Patent 6,014,663).

Regarding claim 3, Official Notice is given that counting number of words in

preamble and body of the claim is well-known in the art.

It would have obvious to one ordinary skill in the art to count the number of words in the preamble and body of a claim to determine the metric breadth of the claim. Such practice is well-known in the field of Patent claim drafting. In this present case, the ordinary skill in the art would have known that the breadth of a claim is inversely proportional to the quantity of limitations recited therein.

Allowable Subject Matter

7.   Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Nakayama (U.S. Patent 5,526,443) teaches method and apparatus for

hightlighting and categorizing documents using coded word token.

Rivette et al. (U.S. Patent 5,623,679) teaches system and method for creating

and manipulating notes each containing multiple sub-notes and linking the sub-notes to

portions of data objects.

Tateno (U.S. Patent 5,778,400) teaches apparatus and method for storing

searching for and retrieving text of a structured document provided with tags.

Rivette et al. (U.S. Patent 5,754,840) teaches a system, method, and computer

program product for developing and maintaining documents which includes analyzing a

patent application with regards to the specification and claims.

Rivette et al. (U.S. Patent 6,339,767) teaches a system, method, and computer

program product using hyperbolic trees to visualize data generated by patent-centric

and group-oriented data processing.

Breitzman et al. (U.S. Patent 6,175,824) teaches a method and apparatus for choosing a stock portfolio based on patent indicators.

Snyder et al. (U.S. Patent 6,038,561) teaches management and analysis of document information text.

Petruzzi et al. (U.S. Patent 6,049,811) teaches machine for drafting a patent application and process for doing same.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Leslie Wong whose telephone number is (703) 305-

3018. The examiner can normally be reached on Monday to Friday 6:30am - 3:00 pm.
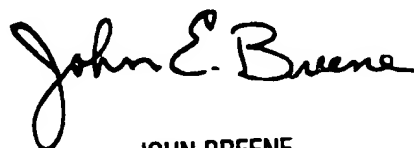
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E Breene can be reached on (703) 305-9790. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 746-7239

for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703)305-

3900.

Leslie Wong
Patent Examiner
Art Unit 2177

lw
February 21, 2002

JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100